

RECEIVED
CENTRAL FAX CENTER

DEC 23 2005

REMARKS

Rejection of claims 87-89 under 35 U.S.C. § 112, second paragraph

The Office rejected claims 87-89 as indefinite. The claim dependency has been amended as suggested by the Office, thereby obviating this rejection.

Rejection of claims 73-96, 100, and 112 for obviousness-type double patenting

The Office rejected claims 73-96, 100, and 112 for obviousness-type double patenting over claims 1 and 8 of US 6,235,973. The applicants herewith submit a terminal disclaimer, thereby obviating this rejection.

Rejection of claims 73-75, 85, 95-96, and 100 under 35 U.S.C. § 102(e)

The Office rejected claims 73-75, 85, 95-96, and 100 as anticipated by Smith (US 5,945,579). For the reasons described below, the applicants respectfully traverse.

Smith cannot anticipate the rejected claims because it is a non-enabling reference. It is well settled that for a prior art publication to anticipate a claim that publication must enable one of ordinary skill in the art to practice the invention.

In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968).

MPEP § 2101.01.

When the claims are drawn to plants, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962)

MPEP § 2121.03. Smith does not provide an enabling disclosure and, therefore, cannot anticipate the present claims.

Smith is directed to

transgenic plants expressing a phytochrome A coding sequence (or biologically active fragment or analogue thereof) which exhibit substantially the same growth pattern and plant architecture as wild-type non-transgenic plants when grown in isolation, but which exhibit proximity-conditional dwarfing, i.e. dwarfing that is not constitutive and which only results when the plants are grown in close proximity to neighboring plants.

Col. 2, ll. 21-29. Smith only mentions Poinsettia plants once in the specification, among a laundry list of plants alleged to be "useful in the ...invention":

Plants useful in the present invention include those of both monocotyledonous and dicotyledonous species, for example agronomic crop plants, horticultural crop plants, and ornamental plants. Agronomic or horticultural crop plants include cereals, non-cereal seed crops, root crops, vegetable crops, horticultural crops, and fruit crops. Cereal crops include wheat, rye, barley, oats, maize, buckwheat, sorghum, and rice. Non-cereal seed crops include peas, beans, soybeans, oil-seed rape, canola, linseed, sunflower, and flax. Root crops include potato, sweet potato, sugar beet, carrot, swede, and turnip. Vegetable crops include asparagus, mustard, lettuce, tobacco, and cauliflower. Horticultural crops include tomato, egg plant, cucumber, celery, melon, and squash. Fruit crops include strawberry, blackberry, blueberry, apple, apricot, peach, pear, plum, orange, cranberry, and lemon. Other crop plants include cotton and sugarcane. Ornamental plants include petunia, chrysanthemum, carnation, poinsettia, begonia, tradescantia, and snapdragon.

Col. 8, ll. 8-25 (emphasis added). However, what Smith lacks is any teaching of any methods by which one could successfully transform poinsettia. As stated in the present specification, at the time of filing the present application there had been no reports of successful production of poinsettia plants. P. 3, ll. 1-2. "Although researchers have reported plant regeneration of poinsettia, none have indicated the successful production of transgenic cells or plants. See, for example, Nataraja *et al.*, *Current Sci.* 42: 577 (1973) ; Gupta, *Current Sci.* 44: 136 (1975) ; Preil, "In Vitro Culture of Poinsettia," in *THE SCIENTIFIC BASIS OF POINSETTIA PRODUCTION*, Stramme (ed.), pages 49-56 (The Agricultural University of Norway 1994)." Specification, p. 9, ll. 31-38.

Smith provides no teachings of how to produce a transgenic poinsettia. As noted previously, it merely lists poinsettia among a laundry list of plants alleged to be useful subjects for expressing the phytochrome A protein. The mere mention of poinsettia is insufficient:

The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003).

MPEP § 2121.01. Smith provides no teachings of how to obtain a transgenic poinsettia. The present inventors were the first to have provided teachings (as disclosed in the present specification) of how to make a transgenic poinsettia plant. Up until the filing the present application, there were no teachings of how to successfully make a transgenic poinsettia.

Where a process for making the compound is not developed until after the date of invention, the mere naming of a compound in a reference, without more, cannot constitute a description of the compound. *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968).

MPEP § 2121.02.

As further evidence of the non-obviousness of the present claims, the applicants note that while poinsettia is reported to be the top-selling flowering plant in the United States and most other major pot and bedding plant crops have been regenerated and transformed, there had been no reports of a transgenic poinsettia before the present application."

In view of the foregoing, the applicants respectfully submit that Smith is a non-enabling reference and, therefore, cannot render the presently pending claims anticipated. The applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection of claims 73-96, 100, and 112 under 35 U.S.C. § 103(a)

The Office rejected claims 73-96, 100, and 112 as obvious over Smith (US 5,945,579), the same reference as applied for the § 102(e) rejection, above. As described below, the applicants respectfully traverse.

Smith fails to render the present claims obvious because of the very same deficiencies discussed above. Namely, Smith is a non-enabling reference. The applicants recognize that a non-enabling reference may be used for an obviousness rejection for all that it teaches. But because Smith is a non-enabling reference, one of ordinary skill in the art could not have a reasonable expectation of successfully making a transgenic poinsettia plant based on Smith's teachings. Not until the filing of the present application was a method made available to make transgenic poinsettia with a reasonable expectation of success.

Without a reasonable expectation of success, the presently claimed transgenic poinsettia plants cannot be obvious. Accordingly, the applicants respectfully request reconsideration and withdrawal of this rejection.

In view of the foregoing amendments and remarks, the applicants believe the pending claims are in condition for allowance. If there are any questions or comments regarding this Response or application, the Examiner is encouraged to contact the undersigned attorney as indicated below.

Date: December 23, 2005

Respectfully submitted,



Michael S. Greenfield
Registration No. 37,142

Telephone: 312-913-0001
Facsimile: 312-913-0002

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606